

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. MCLEOD and DAVID YOUNG

MAILED

JUL 19 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-2205
Application No. 10/699,956

ON BRIEF

Before GARRIS, PAK and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 43-71, which are all of the claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

BACKGROUND

Appellants' invention relates to a method for casting a film comprising a homopolymer of syndiotactic propylene. An understanding of the invention can be derived from a reading of exemplary independent claim 43¹, which is reproduced below.

43. A method comprising:
casting a film comprising a homopolymer of
syndiotactic propylene (sPP) at a film line speed of
from about 35 to about 200 feet per minute.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Shamshoum et al. (Shamshoum) 6,245,857 Jun. 12, 2001

¹ There are two claims numbered as claim 43, an independent claim, and an improper dependent claim (the claim depends from the same numbered claim). It is clear from the brief (see, e.g., page 2) and answer (page 2) that the subject appeal is from rejections that include all of appellants' pending claims, including both claims numbered as claim 43, wherein both claims are referred to in reciting claim 43 therein. In this decision, we shall differentiate between the two claims numbered as claim 43 by employing the terms "independent claim 43" and "dependent claim 43", as necessary. Where we refer to claim 43 without specifying whether it is the independent claim 43 or dependent claim 43, we are referring to both claims numbered as claim 43. Upon return of the application to the Technology Center, corrective action to renumber the claims should be undertaken prior to final disposition of this application.

Claims 43, 44, 48, 52, 53, 56, 64 and 66-71 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Shamshoum. Claims 45-47, 49-51, 54, 55, 57-63 and 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shamshoum.

We refer to the briefs and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

OPINION

Having carefully considered each of appellants' arguments as set forth in the brief and reply brief, appellants have not persuaded us of reversible error on the part of the examiner. Accordingly, we will affirm the examiner's rejections² for substantially the reasons set forth by the examiner in the answer. We add the following for emphasis.

² We note that a separate rejection of claim 54 under the second paragraph of 35 U.S.C. § 112 as set forth in the final action is not before us for review. The examiner vacated (withdrew) that rejection as set forth in Item No. 3 at page 2 of the answer. As another matter, we note that the cover page and second sheet (first page number 2) of the final office action as captured in the electronic file record of this application apparently relates to another application. Correction of the file record is required prior to final disposition of this application in the Technology Center.

§ 102(b) Rejection

At the outset, we note that appellants generally argue the claims subject to this ground of rejection as a group, with remarks (see, e.g., reply brief, page 2) that are asserted to have particular application to product claim 71. Thus, we select independent claim 43 as representative of the rejected method claims 43, 44, 48, 52, 53, 56, 64 and 66-70. We treat product claim 71 separately to the extent separately argued in the briefs.

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); accord Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). Anticipation under this section is a factual determination. See In re Baxter Travenol Labs., 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)). In the case before us, we agree with the examiner's determination that Shamshoum discloses, either expressly or inherently, every limitation of the claimed invention.

Starting with representative independent claim 43, we note that the claimed method requires casting a film at a film line speed of from about 35 to about 200 feet per minute wherein the film comprises a homopolymer of syndiotactic propylene (sPP). Appellants do not dispute that Shamshoum discloses a method of casting a film at a film line speed corresponding to that claimed. Nor do appellants dispute the examiner's determination that Shamshoum discloses that the film can incorporate or include a homopolymer of sPP. See, e.g., the description of Examples 1 and 2 at columns 3 and 4 of Shamshoum.

Rather, appellants maintain that their claimed invention is limited to casting an sPP film "in which the majority of the polyolefin composition is syndiotactic polypropylene" as widely recognized in the art (brief, page 3). In contrast, appellants assert that the use of a small amount (.01 to about 30 %) of sPP in the film that is cast in Shamshoum does not amount to a majority of the polyolefin composition thereof. Thus, appellants contend that Shamshoum is directed to highly isotactic polypropylene (iPP) films rather than the claimed sPP film casting or product that is required by the appealed claims.

We do not find that argument persuasive. Representative independent claim 43 employs the transitional phrase "comprising"

in describing one of the materials (sPP) that the film is required to include without specifying any particular requirement for a minimum percentage, by weight, for the recited sPP film component. The normal usage of the transitional term "comprising" in patent applications and claims is well understood as leaving the so claimed subject matter open to the inclusion of other non-recited elements or steps. See Vehicular Techs. v. Titan Wheel Int'l, Inc., 212 F.3d 1377, 1383, 54 USPQ2d 1841, 1845 (Fed. Cir. 2000). Appellants refer to paragraphs 0011 and 0014 of their application specification in arguing for a narrower interpretation of the claimed subject matter. However, there is no special definition for the transitional term "comprising" that we can find in those portions of appellants' specification that aids appellants claim interpretation argument. Indeed, other paragraphs (such as, paragraphs 0021 and 0022) of appellants' specification undercut appellants' contention in that the particular embodiments disclosed in the specification were intended to be illustrative. In this regard, specification paragraphs 0021 and 0022 make it plain that the claims, as is normally the case, are to be construed in a non-limiting fashion rather than being strictly limited to embodiments that were illustrated in the specification. After all, during examination

proceedings, claim language is given its broadest reasonable interpretation consistent with the specification as it would have been interpreted by one of ordinary skill in the art. See In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995).

Further, appellants' arguments to the effect that Shamshoum defines the term iPP film as requiring the majority of the polyolefin content thereof to be highly isotactic polyolefin at column 2, lines 30-35 thereof is not well taken. That portion of the disclosure of Shamshoum merely notes that the polyolefin composition that Shamshoum is referring to includes a highly isotactic polypropylene, as a majority thereof. Thus, those arguments simply miss the mark in appellants' attempt at narrowing the scope of appellants' claim limitations. When a claim does not recite allegedly distinguishable features, "appellant[s] cannot rely on them to establish patentability." In re Self, 671 F.2d 1344, 1350-1351, 213 USPQ 1, 7 (CCPA 1982).

As for product claim 71, we note that claim is in a product-by-process format and appellants arguments fair no better in relation thereto. While claim 71 does not employ the transitional term "comprising", the film product made by a cast process called for therein has not been shown to be limited to a

film that includes sPP homopolymer as a primary component as argued in the reply brief.

During prosecution of a patent application, the claims therein are given the broadest reasonable interpretation consistent with the specification, as we noted above. See Gechter v. Davidson, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Moreover, concerning appellants' arguments as to that which is known in the art as to the contested claim language, it is well settled that counsel's unsupported arguments in the brief are no substitute for objective evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

It follows that we shall affirm the examiner's anticipation rejection of claims 43, 44, 48, 52, 53, 56, 64 and 66-71 for the reasons set forth above and in the answer.

§ 103(a) Rejection

Concerning the examiner's § 103(a) rejection of claims 45-47, 49-51, 54, 55, 57-63 and 65 over Shamshoum, we note that appellants do not argue against the examiner's obviousness determinations with regard to these dependent claims other than to make the same arguments against this rejection as were made

against the examiner's anticipation rejection based on the features of independent claim 43. Of course, we find those arguments unpersuasive for the reasons advanced above and in the answer. Consequently, we shall also affirm the examiner's obviousness rejection of claims 45-47, 49-51, 54, 55, 57-63 and 65 over Shamshoum, on this record.

CONCLUSION

The decision of the examiner to reject claims 43, 44, 48, 52, 53, 56, 64 and 66-71 under 35 U.S.C. § 102(b) as being unpatentable over Shamshoum; and to reject claims 45-47, 49-51, 54, 55, 57-63 and 65 under 35 U.S.C. § 103(a) as being unpatentable over Shamshoum is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


BRADLEY R. GARRIS

Administrative Patent Judge)
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CHUNG K. PAK)
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Administrative Patent Judge)
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